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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/641,030

08/17/2000

Leanne M. Capozzi

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12/11/2006

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EXAMINER

HENDERSON, MARK T

ART UNIT

PAPER NUMBER

3722

DATE MAILED: 12/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/641,030

Applicant(s)

CAPOZZI ET AL.

Examiner

Mark T. Henderson

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 and 53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 11-14, 16, 17, 20, 22, 23 and 53 is/are rejected.
- 7) ☒ Claim(s) 8-10, 15, 18, 19, 21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED OFFICE ACTION**

### **Faxing of Responses to Office Actions**

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing or responses to Office Actions directly into the Group at (571) 273-8300. This practice may be used for filing papers, which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claims 1-23 and 53 are pending. Claims 24-52 have been canceled. After further review and consideration, the examiner has decided to withdraw the finality of the previous office action and submit a new rejection as stated below.

### ***Claim Objections***

2. Claim 5 is objected to because of the following informalities: Claim 5 discloses the limitation: "said service provider" which lacks antecedent basis. Appropriate correction is required.

3. Claim 17 is objected to because of the following informalities: Claim 17 discloses the limitation, "a plurality of image". Should this be a "plurality of images"? Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11, 22 and 53 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 11, 22 and 53 recites the limitation "machine readable code". There is insufficient antecedent basis for this limitation in the claim. It is not clearly understood which machine readable code applicant is speaking of, since there is a "machine readable code" for the labels, and a "machine readable code" for the instruction forms. Applicant must distinguish between the two.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4, 11, 22, 23 and 53, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Barber et al (4,204,639) in view of Dunn (5,243,173), and further in view of Schulz (5,233,531).

Barber et al discloses in Fig. 7 and 8, a kit comprising: a plurality of labels (1) each label having a machine-readable code (14) in the form of an icon (bar code); wherein the code comprises a color (Col. 4, lines 25-45, and Col. 5, lines 60-65), wherein the machine code is interpreted by a scanning device (not shown).

However, Barber et al does not disclose: instruction forms having machine readable code to associate each of the instruction forms with a label; at least one order form having machine-readable instructions.

Schulz discloses in Fig. 3, an instruction form (60) having a machine-readable code (252).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Barber et al's kit with a second document having instructions

and a machine readable code as taught by Schulz for providing a document for instructing the end user.

However, Barber et al, as modified by Schulz, does not disclose: at least one order form having machine-readable instructions.

Dunn discloses in Fig. 2, an order form (10) having machine-readable instructions (14a-14f), wherein the bar codes are instructions (Col. 2, lines 60-68) written in a visual format and printed on a hard copy.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Barber et al's and Schulz's kit with an order form having machine readable instructions as taught by Dunn for providing a document which instructs an end user.

In regards to **Claims 1, 2 and 53**, wherein the label machine code is used "to identify a separate category of customer provided hard copy images"; instruction form code used "to associate each of the instructions forms with a separate label" and "to provide information to each customer provided hard copy image associated with the separate label; machine-readable instructions used "to associate one or more of the separate category of customer provided hard copy images with at least one good or service" and "for ordering that service"; instructions used "for the customer on how to use the kit"; and a scanning device used "to provide meta-data regarding one or more subsequent images, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure

is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. Therefore, the machine-readable label code can be used to identify any means; the machine-readable instruction code can be used to associate any form with another form and provide information in any manner; the machine-readable instructions can be used to associate with any other form, and for ordering in any manner; and a scanning device can be used to provide any type of a data.

In regards to **Claim 23**, it would have been obvious to one having skill in the art to construct the instruction forms in any desirable size, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. Therefore, it would have been to construct the instruction forms with any desirable dimension, since applicant has not disclosed the criticality of having a particular size, and invention would function equally as well if constructed in any desirable size.

6. Claims 5-7, 12-14, 16, 17, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barber et al as modified by Schulz and Dunn, and further in view of Petroff (4,730,727).

Barber et al, as modified by Schulz and Dunn, discloses a kit comprising all the elements as claimed in Claim 1, and as set forth above. However, Barber et al does not disclose: a holder having pockets or an envelope; a container having a holding section designed to hold a computer

disk, CD, photo album or flash card, wherein the holder further comprises a plurality of pockets; or a carrier having a retaining member located at one end of the carrier.

Petroff discloses in Fig. 11, a holder, container or carrier (A) having pockets, envelopes, or a holding section (11 and 12) designed to hold a computer disk (see abstract), and a retaining member (50) located at one end of the carrier (see Fig. 11).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Barber et al's, Schulz's and Dunn's kit with a holder, container or carrier as taught by Petroff for providing a means in which to hold items securely.

In regards to **Claims 5, 6, 12, 13, 14, 16, 17, and 20**, wherein: the holder is used "for organizing images obtained by scanning said hard copy prints by the service provider"; the pockets are used "for organizing said hard copy prints" and used for "associating the instruction form with the plurality of hard copy images"; a container used "for holding said plurality of images"; a container section used "for holding images provided in other formats"; pockets used "for categorizing of said plurality of images provided by said customer"; a carrier used "for holding on the of said plurality of images for allowing automatic feeding of said one of the plurality of images through a scanning device" and a retaining member used "for securely holding said hard copy prints that are to be scanned", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to



the prior art. Therefore, the holder, pockets, container, container section, carrier, and retaining member, can be used in any desirable manner.

*Allowable Subject Matter*

7. Claims 8-10, 15, 18, 19, 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Response to Arguments*

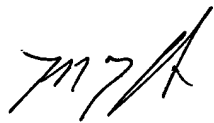
8. Applicant's arguments with respect to claims 1-23 and 53 have been considered but are moot in view of the new ground(s) of rejection.

Barber et al, Schulz, and Dunn are now used to disclose a kit comprising labels, instruction forms, and order forms. Petroff is also used to disclose a holder, carrier, envelope and pockets. In regards to **Claims 1, 2 and 53**, wherein the label machine code is used "to identify a separate category of customer provided hard copy images"; instruction form code used "to associate each of the instructions forms with a separate label" and "to provide information to

each customer provided hard copy image associated with the separate label; machine-readable instructions used “to associate one or more of the separate category of customer provided hard copy images with at least one good or service” and “for ordering that service”; instructions used “for the customer on how to use the kit”; and a scanning device used “to provide meta-data regarding one or more subsequent images, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. Therefore, the machine-readable label code can be used to identify any means; the machine-readable instruction code can be used to associate any form with another form and provide information in any manner; the machine-readable instructions can be used to associate with any other form, and for ordering in any manner; and a scanning device can be used to provide any type of a data. The limitations disclosed in applicant’s claims comprise of intended use language. Since the intended use does not result in a structural difference, the claims can not be patentable. Applicant must clearly disclose the structural limitations (Ex., images, hard copy prints, etc.) in further detail.

**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (571) 272-4477, and informal fax number is (571) 273-4477. The examiner can be reached on Monday-Friday from 9:00AM to 3:45PM. If attempts to reach the examiner by telephone are unsuccessful, the Examiner Supervisor, Monica Carter, can be reached at (571) 272-4475. The formal fax number for TC 3700 is (571) 273-8300.



MTH

December 6, 2006

  
MONICA CARTER  
SUPERVISORY PATENT EXAMINER